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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,069	02/19/2004	Heribert Bucher	16589-4	1155

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EXAMINER
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STOCK JR, GORDON J

ART UNIT	PAPER NUMBER
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2877

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/784,069	Applicant(s) BUCHER ET AL.	
	Examiner Gordon J. Stock	Art Unit 2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-15 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20040219</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The Preliminary Amendment received on February 19, 2004 has been entered into the record.

#### *Priority*

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on 8/16/02. It is noted, however, that applicant has not filed a certified copy of the PCT/EP02/09183 application as required by 35 U.S.C. 119(b).

#### *Information Disclosure Statement*

3. The information disclosure statement (IDS) submitted on February 19, 2004 is being considered by the examiner.

#### *Drawings*

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the control system of **claim 19** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claim 18** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Even though the specification lacks antecedent basis for the claimed subject matter (see above), no where in the specification is there description of position determining geometry or a suggestion of determining geometry from position determination to enable one skilled in the art to make and/or use the invention because the specification solely describes determining position of the tool and not anything concerning determining geometries using position determination (page 1, lines 9-20; page 2, lines 18-33; page 3, lines 1-30; Figs. 2-5).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 11-14, 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bucher et al. WO 01/28737—cited by applicant using Bucher et al. (6,597,464) as a translation.**

As for **claim 11**, Bucher in a method and device for testing a cutting-edge geometry discloses the following: rotating a rotationally drivable tool (col. 6, lines 42-45); choosing a movement direction (col. 6, lines 65-67; col. 7, lines 1-3); moving the tool in the chosen direction, away from the measuring beam to a measuring position in which the tool is separated from the measuring beam (col. 7, lines 19-22 and lines 30-35); detecting the measuring position (col. 7, lines 30-35); wherein, the tool is positioned in the beam path of the measuring beam before it is moved away from the measuring beam (col. 6, lines 65-67; col. 7, lines 1-3); the measuring position is detected for a position of the tool in which the measuring beam is not interrupted during at least one revolution of the tool (col. 7, lines 19-22 and lines 30-35).

As for **claim 12**, Bucher discloses everything as above (see **claim 11**). In addition, he discloses positioning the tool in the beam path of the measuring beam in such a manner that the measuring beam is interrupted (col. 7, lines 38-40).

As for **claim 13**, Bucher discloses everything as above (see **claim 11**). In addition, he discloses the tool is positioned in the beam path of the measuring beam in such a manner that the measuring beam is periodically interrupted by the rotating tool (Figs. 7-10).

As for **claim 14**, Bucher discloses everything as above (see **claim 11**). In addition, the tool is rotated at a predetermined rotational speed (col. 7, line 20).

As for **claim 17**, Bucher discloses everything as above (see **claim 11**). In addition, the tool is moved away from the measuring beam is ended when the measuring position is reached (col. 7, lines 24-26).

As for **claim 18**, Bucher discloses everything as above (see **claim 11**). In addition, he discloses the geometry of the tool is determined from the measuring position (col. 10, lines 48-51).

As for **claim 19**, Bucher discloses everything as above (see **claim 11**). In addition, he discloses a control system (Fig. 1: 16); an optical measuring device (Fig. 1: 10, 12, 14, 16, 18); the control system is programmed (col. 5, lines 30-35).

As for **claim 20**, Bucher discloses everything as above (see **claim 19**). In addition, Bucher discloses a transmitter and receiver (Fig. 1: 10 and 12).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bucher et al. WO 01/28737**—cited by applicant using **Bucher et al. (6,597,464)** as a translation.

As for **claim 15**, Bucher discloses everything as above (see **claim 11**). He does not explicitly state that the tool is moved at a predetermined velocity. He does state that the tool's type of movement is necessary to ensure that the test region enters the measuring range (col. 7, lines 10-15). Therefore, it would be obvious to one of ordinary skill in the art that the tool is

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moved at a predetermined velocity in order to ensure that the test region enters the measuring range.

*Allowable Subject Matter*

11. **Claim 16** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to **claim 16**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method of determining position of a rotationally drivable tool wherein the tool position is determined in dependence on the rotational speed and the movement velocity of the tool, in combination with the rest of the limitations of **claim 16**.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent 4,966,460 to Kahley

*Fax/Telephone Numbers*

If the applicant wishes to send a fax dealing with either a proposed amendment or a discussion with a phone interview, then the fax should:

1) Contain either a statement "DRAFT" or "PROPOSED AMENDMENT" on the fax cover sheet; and

2) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

*Papers related to the application may be submitted to Group 2800 by Fax transmission. Papers should be faxed to Group 2800 via the PTO Fax machine located in Crystal Plaza 4. The*

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*form of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine number is: (571) 273-8300*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon J. Stock whose telephone number is (571) 272-2431.

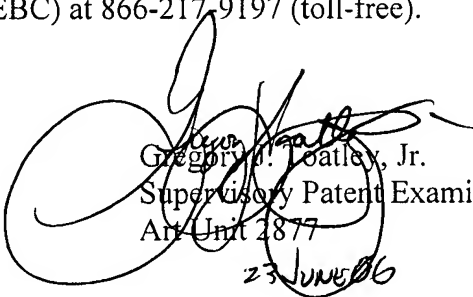
The examiner can normally be reached on Monday-Friday, 10:00 a.m. - 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr., can be reached at 571-272-2800 ext 77.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gs

June 22, 2006

  
Gregory J. Toatley, Jr.  
Supervisory Patent Examiner  
Art Unit 2877

23 June 06